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AKD

Serial No. 09/939,491

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal No.:	2007-0186
Serial no.:	09/939,491
Filing date:	08/24/2001
For:	Clematis Plant named 'Avalanche'
Inventor:	Anthony Robin White
Atty. Docket no.:	PH41
Group Art Unit:	1655
Examiner:	McCormick
Confirmation no.:	3293

RESPONSE TO APPEAL BOARD ORDER UNDER 37 CFR 41.50(d).

In response to the order under 37 CFR 41.50(d) mailed on February 28, 2007, Appellant submits the following response to the issues cited in the order.

I. The public use and availability of a plant variety outside of the United States

1. The public use and availability of a plant variety outside of the United States was determined to not be material to the determination of the patentability of a plant variety in the United States under 35 USC 102(b) in LeGrice (301 F.2d 929 (CCPA 1962). LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

2. The court in LeGrice (301 F.2d 929 (CCPA 1962) established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents. LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Both Legrice and the USPTO have stated that both plants and utility patents should have the same 102(b) bars. Legrice confirms that plant patents should receive the same consideration under 102(b) as utility patents.

Appellants believe that the correct standard for a bar under 102(b) for plant patents is a publication more than 1 year old coupled with enablement within the United States.

II. LeGrice

1. Appellants believe that the holdings of Elsner are in conflict with LeGrice.

2. The court in LeGrice (301 F.2d 929 (CCPA 1962)) established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents. LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Both Legrice and the USPTO have stated that both plants and utility patents should have the same 102(b) bars. The LeGrice court held that "plant descriptions in prineted publications of new plant varieties, before they may be used as statutory bars under 35 USC 102(b), must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases." (*Legrice*, 301 F.2d at 944)

Legrice confirms that plant patents should receive the same consideration under 102(b) as utility patents. Because the courts and the USPTO have stated that 102(b) should be applied to all patents equally, the holding in Elsner raises the possibility that foreign use of an invention could be a bar in utility patent cases, which is clearly in conflict with 35 USC 102(b).

III. Importation of foreign nursery stock into the United States

1. Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States.

The quarantine act imposes several importation requirements that are applicable to all cultivars of Clematis. The importation of plants of 'Avalanche' into the United States would require a phytosanitary certificate of inspection issued in the country of origin and a written import permit issued by the United States Department of Agriculture (USDA), which permit specifically refers to restricted articles. The phytosanitary certificate of inspection certifies that the plants are free from diseases and pest that could cause damage in the United States if imported.

In addition, the USDA may require a period of quarantine to observe the new cultivars for insects and diseases. In some instances, these quarantine periods may be as long as two years. There is therefore a double check on imports of plants into the United States.

These inspections take time in order to ensure the safety of the plants being imported. Therefore, if one skilled in the art did follow the procedures specified by the Plant Quarantine Act of 1912, they would be adding an additional time period before plants were able to be imported into the United States.

IV. The 1998 sale of the claimed plant in the United Kingdom

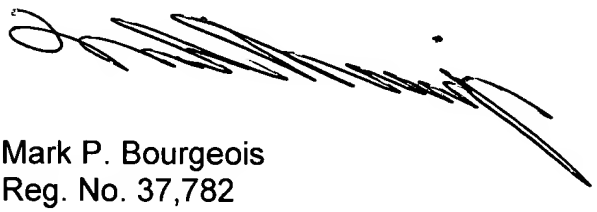
1. The sale of plants in the Fall of 1998 was to a single wholesale nursery for the purpose of building up a sufficient supply of plants to support commercial sales at a later date. The sale of plants in the Fall of 1998 was a single solitary occurrence that would not have been known to one skilled in the art.

2. All plants of Clematis 'Avalanche' that were sold to the public would have flower buds initiated in all leaf nodes making the plant unsuitable for propagation at that time. After flowering, Clematis 'Avalanche' must be cut back and allowed to regenerate new growth. Terminal cuttings can only be taken in late summer before the shortening of daylight hours initiates flower bud production for the following spring. Therefore, there is a very small window of time during the year during which Clematis 'Avalanche' can be successfully propagated.

Assume hypothetically, that one skilled in the art had read the PBR publication for 'Avalanche' and was able to purchase plants of 'Avalanche'. The office states that the plant breeders rights (PBR) publication would be enabled by the reproduction or propagation of 'Avalanche'. Because 'Avalanche' was only available in the United Kingdom and was covered by a PBR grant, unlicensed propagation of 'Avalanche' would been an illegal act in the United Kingdom. It is not logical for the U.S. patent office to require a hypothetical person to perform an act that would be illegal in a foreign country in order to reject a patent application in the United States.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,



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